## REMARKS

Claims 1-6, 8-9, 12-13, 15-16, 18-20, 22-24, 26-27, 29-30, 37-39, and 43-45 are pending in this application. The specification has been amended to clarify further the claim of priority, which was included in the Application Data Sheet submitted with the filing of the present application and which was recognized by the Office in the filing receipt mailed on August 9, 2005. No new matter has been added.

The Office has required restriction between 18 groups:

**Group I**, claims 1-6, 8, 9, 12, 13, 15, 16, 18-20, 22-24, 26, 27, 29, 30 and 43 drawn to products of the formula (Ia) or (II) wherein $R_2$ is halogen or $C_{1-12}$ haloalkyl and $R_3$ is heteroaryl-$C_{1-4}$-alkylene.

**Group II**, claims 1-6, 8, 9, 12, 13, 15, 16, 18-20, 22-24, 26, 27, 29, 30 and 43 drawn to products of the formula (Ia) or (II) wherein $R_2$ is halogen or $C_{1-12}$ haloalkyl and $R_3$ is $C_{3-6}$ cycloalkyl or $C_{3-6}$ cycloalkyl-$C_{1-4}$-alkylene.

**Group III,** claims 1-6, 8, 9, 12, 13, 15, 16, 18-20, 22-24, 26, 27, 29, 30 and 43 drawn to products of the formula (la) or (II) wherein $R_2$ is halogen or $C_{1-12}$ haloalkyl and $R_3$ is $C_{1-12}$ alkyl.

**Group IV,** claims 1-6, 8, 9, 12, 13, 15, 16, 18-20, 22-24, 26, 27, 29, 30 and 43 drawn to products of the formula (Ia) or (II) wherein $R_2$ is halogen or $C_{1-12}$ haloalkyl and $R_3$ is $C_{1-12}$ haloalkyl.

**Group V**, claims 1-6, 8, 9, 12, 13, 15, 16, 18-20, 22-24, 26, 27, 29, 30 and 43 drawn to products of the formula (Ia) or (II) wherein $R_2$ is halogen or $C_{1-12}$ haloalkyl and $R_3$ is aryl-$C_{1-5}$-alkylene.

**Group VI**, claims 1-6, 8, 9, 12, 13, 15, 16, 18-20, 22-24, 26, 27, 29, 30 and 43 drawn to products of the formula (la) or (II) wherein $R_2$ is H or $C_{1-12}$ alkyl and $R_3$ is heteroaryl-$C_{1-4}$-alkylene.

**Group VII**, claims 1-6, 8, 9, 12, 13, 15, 16, 18-20, 22-24, 26, 27, 29, 30 and 43 drawn to products of the formula (Ia) or (II) wherein $R_2$ is H or $C_{1-12}$ alkyl and $R_3$ is $C_{3-6}$ cycloalkyl or $C_{3-6}$ cycloalkyl-C1-4-alkylene.

**Group VIII**, claims 1-6, 8, 9, 12, 13, 15, 16, 18-20, 22-24, 26, 27, 29, 30 and 43 drawn to products of the formula (Ia) or (II) wherein $R_2$ is H or $C_{1-12}$ alkyl and $R_3$ is $C_{1-12}$ alkyl.

**Group IX**, claims 1-6, 8, 9, 12, 13, 15, 16, 18-20, 22-24, 26, 27, 29, 30 and 43 drawn to products of the formula (Ia) or (II) wherein $R_2$ is H or $C_{1-12}$ alkyl and $R_3$ is aryl-$C_{1-5}$-alkylene.

**Group X**, claims 1-6, 8, 9, 12, 13, 15, 16, 18-20, 22-24, 26, 27, 29, 30 and 43 drawn to products of the formula (Ia) or (II) wherein $R_2$ is H or $C_{1-12}$ alkyl and $R_3$ is $C_{1-12}$ haloalkyl.

**Group XI**, claims 37-39, 44 and 45 drawn to methods of use for the products of the formula (Ia) wherein $R_2$ is halogen or $C_{1-12}$ haloalkyl and $R_3$ is heteroaryl-$C_{1-4}$-alkylene.

**Group XII**, claims 37-39, 44 and 45 drawn to methods of use for the products of the formula (Ia) wherein $R_2$ is H or $C_{1-12}$ alkyl and $R_3$ is $C_{1-12}$ haloalkyl.

**Group XIII**, claims 37-39, 44 and 45 drawn to methods of use for the products of the formula (Ia) wherein $R_2$ is H or $C_{1-12}$ alkyl and $R_3$ is aryl-$C_{1-5}$-alkylene.

**Group XIV**, claims 37-39, 44 and 45 drawn to methods of use for the products of the formula (Ia) wherein $R_2$ is H or $C_{1-12}$ alkyl and $R_3$ is $C_{1-12}$ alkyl.

**Group XV**, claims 37-39, 44 and 45 drawn to methods of use for the products of the formula (Ia) wherein $R_2$ is H or $C_{1-12}$ alkyl and $R_3$ is $C_{3-6}$ cycloalkyl or $C_{3-6}$ cycloalkyl-$C_{1-4}$-alkylene.

**Group XVI**, claims 37-39, 44 and 45 drawn to methods of use for the products of the formula (Ia) wherein $R_2$ is H or C1-12 alkyl and $R_3$ is heteroaryl-$C_{1-4}$-alkylene.

**Group XVII**, claims 37-39, 44 and 45 drawn to methods of use for the products of the formula (Ia) wherein $R_2$ is halogen or $C_{1-12}$ haloalkyl and $R_3$ is $C_{3-6}$ cycloalkyl or $C_{3-6}$ cycloalkyl-$C_{1-4}$-alkylene.

**Group XVIII**, claims 37-39, 44 and 45 drawn to methods of use for the products of the formula (Ia) wherein $R_2$ is halogen or $C_{1-12}$ haloalkyl and $R_3$ is $C_{1-12}$ alkyl.

The Office further states that the Applicants can either elect one of these "exemplary" groups, identify another specific embodiment of "similar scope to the exemplary groups which is not listed in the exemplary groups of the invention", or "elect a single disclosed species or single disclosed species for a single method" (Office Action, page 3). If Applicants chooses the second option, the Office states that it will endeavor "to group the same" (Office Action, page 3). If Applicants choose the third option, the Office states that it will attempt to create a group "comprising the elected species of similar scope to the exemplary groups" (Office Action, page 3). Applicants elect Group III, drawn to products of the formula (Ia) or (II) wherein $R_2$ is

halogen or $C_{1-12}$ haloalkyl and $R_3$ is $C_{1-12}$ alkyl, **with traverse**. As a preliminary matter, Applicants respectfully note that the Office's listing of the claims readable on each Group is inaccurate. Accordingly, Applicants note that claims 1, 3, 4, 8, 9, 12, 13, 29, 30, and 43 read on the variables identified in elected Group III.

At the onset, it is noted that restriction is at the discretion of the Examiner to be exercised only after the application is found to lack unity of invention. 37 C.F.R. § 1.499; M.P.E.P. § 1893.03(d). *See also*, M.P.E.P. § 803.01 (stressing that it is imperative that restriction be carefully administered as it is at the discretion of the Director). Further, upon exercising that discretion, M.P.E.P. § 1893.03(d) provides that "the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group." This listing of the groups is required in order to "provide a clear and detailed record of the restriction requirement to provide a clear demarcation between restricted inventions so that it can be determined whether inventions claimed in a continuing application are consonant with the restriction requirement and therefore subject to the prohibition against double patenting rejections under 35 U.S.C. § 121." M.P.E.P. § 814, citing *Geneva Pharmaceuticals. Inc. v. GlaxoSmithKline* PLC, 349 F.3d 1373, 1381 (Fed. Cir. 2003). Failure to comply with this simple requirement can potentially deprive the applicant of the protection of 35 U.S.C. § 121 for any later filed divisional application by failing to clearly define the line of demarcation between the elected and non-elected groups.

It should also be evident that the listing of the restricted groups must not arbitrarily exclude claimed subject matter from the listing, leaving voids in the claimed subject matter. As will be appreciated, an applicant has a right to have each claim examined on the merits. *In re Weber*, 198 U.S.P.Q. 328, 331 (C.C.P.A. 1978). Restriction of a single Markush claim into several subgenera, however, may deprive an applicant of this right. In *Weber*, the CCPA cautioned that:

> If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in

> several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification.

198 U.S.P.Q. at 331. Hence, when the Office fragments a single Markush claim into several groups, the definition of those groups may result in the totality of the resulting fragmentary claims not being equivalent to the original claim, for example, by introducing voids and ambiguities. *Id.* Such voids may improperly withdraw claimed subject matter permanently from consideration not only in the pending application, but also prospectively in any subsequent application. *See In re Haas*, 179 U.S.P.Q. 623, 625 (C.C.P.A. 1973) (holding that an Examiner's withdrawal of claims under 35 U.S.C. 101 and 121 as being multiple patentable distinct inventions amounted to a rejection and an improper withdrawal of the claims from consideration in any subsequent application). Further, the Office may define the subgeneric groups completely apart from the written description embraced by the dependent claims and the specification, such that one or more of the groups lack written description support. *Id.* (citing *Fields v. Conover*, 170 U.S.P.Q. 276 (C.C.P.A. 1971), wherein a subgenus was not described by a genus, and *In re Ruschig*, 154 U.S.P.Q. 118 (C.C.P.A. 1967), wherein a species was not described by a genus).

The current restriction requirement contravenes these basic principles. Rather, than listing the different groups of claims and explaining why each group lacks unity with each other group, the Office has improperly set forth 18 "exemplary" and "not exhaustive" groups because "a precise listing of the inventive groups cannot be made" due to "the numerous and widely divergent subject matter claimed" (Office Action, pages 2-3). Despite any protestations to the contrary, the Office is required by M.P.E.P. § 1893.03(d) to make a precise listing of the inventive groups when exercising its discretion to make a restriction. The Office has failed to comply with this requirement.

Even more troubling, the Office's listing is "not exhaustive" and fails to include all of the claimed subject matter within the 18 "exemplary" groups. For example, while Group IV and V are drawn to products of formula (Ia) or (II) wherein $R_2$ is halogen or $C_{1-12}$ haloalkyl and $R_3$ is $C_{1-12}$ haloalkyl in Group IV and $R_2$ is halogen or $C_{1-12}$ haloalkyl and $R_3$ is aryl-$C_{1-5}$-alkylene in

Group V, the Office's listing does not include methods of using the compounds of Groups IV and V. The Office's failure to include this claimed subject matter in the listing leaves voids in the claimed subject matter, effectively withdrawing the subject matter from examination from examination from the present and *subsequent* applications and potentially deprives Applicants of protection of 35 U.S.C. § 121 for a later-filed divisional application.

The Office also fails to explain why each group lacks unity with each other group and fails to describe the unique special technical feature in each group. Instead, the Office merely states generally that the pyrazole ring of the compounds of Formula (Ia) and (II) does not constitute a special technical feature, but fails to explain why each group lacks unity with the other 17 groups of the restriction requirement. In particular, the Office fails to describe specifically the unique special technical feature in each of the 18 groups. The lack of description of the unique special technical feature for each group suggests the restriction requirement is completely arbitrary in nature.

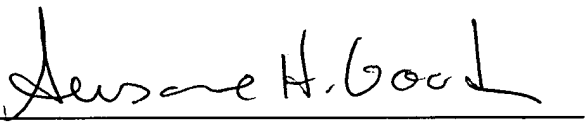
As to allowing, in the alternative, Applicants to set forth their own exemplary group or species, restriction is clearly at the discretion of the Examiner to be exercised only after each group is found to lack unity of invention with every other group. Moreover, even if Applicants were to suggest a new exemplary group of similar scope to the 18 listed groups or were to suggest a species as a starting point for the Examiner to craft yet another exemplary group, this procedure would still not result in a clear and precise listing of the restriction requirement, which the Office must provide when requiring restriction.

For the above reasons, it is clear that the outstanding restriction requirement is seriously flawed. Applicants respectfully request that the restriction requirement be withdrawn or, at a minimum, that the products of Groups I to X be rejoined as a single group.

The Commissioner is hereby authorized to debit any fee due or credit any overpayment to Deposit Account No. 06-1050. Further, if not accompanied by an independent petition, this paper constitutes a Petition for an Extension of Time for an amount of time sufficient to extend the deadline and authorizes the Commissioner to debit the petition fee and any other fees or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: July 2, 2008



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